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10/689,005	10/20/2003	Christopher Goode	SEDN/132DIV1	4102

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EXAMINER
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THOMAS, JASON M

ART UNIT	PAPER NUMBER
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2623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/689,005	<b>Applicant(s)</b> GOODE ET AL.	
	<b>Examiner</b> Jason Thomas	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/03</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18 are, drawn to a user-requested video program method and apparatus used to provide subscription-on-demand services for an interactive information distribution system by permitting the user to subscribe to a group of programs, classified in class 725, subclass 86.
- II. Claims 19-24 are, drawn to a billing method in a video distribution system used to provide dynamic pricing for information distributed, classified in class 725, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as a method for dynamically pricing, independent of permitting a user to select programming packages. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the

allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Eamon Wall on May 6th, 2008 a provisional election was made without traverse to prosecute the invention of

subcombination I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 7 is objected to because of the following informalities: In claim 7 applicant states the steps of, "sending a second menu applet **from** said subscriber equipment **to** said service provider equipment" where "decoding and executing said second menu applet" takes place "within said subscriber equipment". Based on the claim language there appears to be a misstatement of which device receives the applet to decode to be decoded.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (U.S. Patent No. 6,016,141) in view of Brown (U.S. Patent No. 5,771,435).

**Regarding claim 1:** Knudson discloses an interactive information distribution system containing service provider equipment and subscriber equipment that is interconnected by a communications network (see [fig. 1]), a method of providing a subscription-on-demand service for an interactive information distribution system comprising the steps of: packaging a number of programs into a programming packages; and enabling a subscriber to access any program within a subscribed programming package (see [abstract], [col. 1, ll. 57-63], [col. 3, ll. 2-16], [col. 4, ll. 58-65]).

Knudson is silent on allowing a user to access a program in an on-demand basis.

Brown however teaches a system that processes request for programming by providing the user with the option of near video on demand or video on demand (see [abstract], [col. 2, ll. 14-23], [col. 2, ll. 55-67], [col. 3, ll. 31-51]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide a user with the option of receiving programming in an on-demand basis, as taught in Brown, when providing access to programming through subscription-on-demand services, as taught in Knudson, because providing users with videos in an on-demand basis is in accordance

with providing an interactive services to simplify home entertainment by allowing viewers greater flexibility and control over content (see Brown: [col. 1, ll. 23-24]).

**Regarding claim 2:** Knudson in view of Brown discloses the method of claim 1 further comprising the step of: enabling a consumer to select a programming package and subscribe to the selected programming package for a predefined price and thereby become said subscriber (see Knudson: [fig. 6, items 92, 98 and 114], [col. 3, ll. 9-16], [col. 6, ll. 55-57]).

**Regarding claim 3:** Knudson in view of Brown discloses the method of claim 1 wherein a subscriber is limited to on-demand access to on-demand programs within the subscribed programming package only during predefined time periods without incurring an additional fee (see Knudson: [col. 6, ll. 22-27], [col. 8, ll. 58-63]).

**Regarding claim 4:** Knudson in view of Brown discloses the method of claim 1 wherein said on-demand programming within said programming package is defined by the subscriber (see Knudson: [col. 5, ll. 13-24], [col. 6, ll. 33-35]).

**Regarding claim 5:** Knudson in view of Brown discloses the method of claim 1 wherein the programming packages are arranged in a hierarchical format having subsets of programming packages within a programming package to enable a viewer to subscribe to a programming package subset without subscribing to an entire programming package (see Knudson: [fig. 7], [fig. 8], [col. 5, ll. 13-24], [col. 6, ll. 4-35], [col. 6, ll. 33-35]).



**Regarding claim 6:** Knudson in view of Brown discloses the method of claim 1 wherein a consumer selects a programming package and subscribes thereto by manipulating a graphical user interface (see Knudson: [fig. 2], [fig. 6], [col. 1, ll. 57-63]).

3. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. in view of Brown and Goode et al. (International Pub. No. 98/19459).

**Regarding claim 7:** Knudson in view of Brown discloses in an interactive information distribution system containing service provider equipment and subscriber equipment that is interconnected by a communications network, a method of providing a subscription-on-demand service for an interactive information distribution system comprising the steps of: sending from said service provider equipment to said subscriber equipment a first menu applet; decoding and executing said first menu applet within said subscriber equipment to display a first interactive graphical user interface; selecting, through manipulation of the first interactive graphical user interface, a subscription option (see [fig. 7] for a menu applet; see also [col. 3, ll. 45-62] transmitting data between the distribution facility and user equipment; [col. 3-4, ll. 63-3] for decoding by demodulation, the transmissions; [col. 4, ll. 42-47], [col. 4, ll. 58-65] for displaying an executed GUI received from the received transmissions which the user can select from); sending a second menu applet from said subscriber equipment to said service provider equipment; decoding and executing said second menu applet within said subscriber equipment to display a second interactive user interface through

which the subscriber can select a subscription program for viewing (see [fig. 8] in view of the process for the first said GUI); if said subscriber is not said current subscriber, sending a third menu applet from said subscriber equipment to said service provider equipment; and decoding and executing said third menu applet within said subscriber equipment to display a third interactive user interface through which the subscriber can become a subscriber to the selected service (see Knudson: [fig. 9], [col. 2, ll. 53-56], [col. 7, ll. 49-57] in view of the process for the first GUI).

Knudson is silent on a signal indicative of said selected subscription option from said subscriber equipment to said service provider equipment; and determining within said subscriber equipment if the subscriber is a current subscriber to said service identified by said selection signal.

Goode however teaches an information server that provides data streams in response to selection request (which reads on a signal) for information from an interactive network interface after authenticating a terminal account (which reads on a subscription) (see [fig. 1], [pp. 5, ll. 12-13], [pp. 5-6, ll. 33-2], [pp. 6-7, ll. 24-6]).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to use a selection signaling mechanism such as a information request to indicate a request for information prior to validating a user, allowing the user to receive data, as taught in Goode, when providing subscription on-demand services, as taught in Knudson, because some form of

signaling mechanism is required to convey the user's selection via a graphical user interface to a remote device such as an information server and because some form of validation technique is necessary to provide security to the interactive information distribution system (see [pp. 1, ll. 32-33]).

**Regarding claim 8:** Knudson in view of Brown and Goode discloses the method of claim 7 wherein second menu applet is connected to other menu applets that provide interactive displays of categories of services, titles of programs available in each category, and program pricing for each tile (see Knudson: [col. 3, ll. 9-16], [col. 4, ll. 32-37], [col. 4, ll. 42-47], [col. 4, ll. 58-65]).

**Regarding claim 9:** Knudson in view of Brown and Goode discloses the method of claim 7 further comprising the step of: if a new subscription is created, updating a subscription database within said service provider equipment to identify the subscriber as a subscriber to the selected service (see Knudson: [fig. 6], [col. 3, ll. 22-31], [col. 6, ll. 42-51] for service provider equipment database that is updated as indicated by it updating the user equipment database).

**Regarding claims 10 and 11:** Knudson in view of Brown and Goode teaches authorizing a user to subscribe on-demand to programming and programming packages through the use of a graphical user interface (GUI) and performing some action in response (see Knudson: [fig. 2], [fig. 6], [fig. 7], [col. 3, ll. 27-31], [col. 4, ll. 42-47], [col. 4, ll. 58-65]) but does not disclose the method of claim 7 further comprising the step of: if a subscriber requests a new subscription, sending a fourth menu applet from said service provider equipment

and decoding and executing said fourth menu applet within said subscriber equipment to display a menu that requests a personal identification number (PIN) or master PIN for said subscriber.

Goode teaches an access authorization routine which request a personal identification number (PIN) or master PIN using an interactive graphical method which is executed upon a customer requesting access to information on an information distribution system (see [fig. 3 items 326 & 328], [pp. 2-3, ll. 33-32], [pp. 6-7, ll. 24-6]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to execute a routine capable of using an interactive graphical method to require a user to enter a PIN or master PIN, as taught in Goode, when authorizing a user to subscribe to on-demand programming and programming packages, as taught in Knudson, because it is often necessary to provide system security for interactive information distribution systems (see [pp. 1, ll. 32-33]).

**Regarding claim 12:** Knudson in view of Brown and Goode discloses the method of claim 7 wherein the subscriber selects programming for a personal subscription-on-demand service and a personal subscription-on-demand option is included in said display produced from said first menu applet (see Knudson: [fig. 8] where an option selected is included in a package which can be selected; see also [col. 6, ll. 22-35] for alternative subscription on-demand options).

**Regarding claim 13:** Knudson in view of Brown and Goode discloses the method of claim 7 wherein said subscription-on-demand services are arranged in a hierarchical structure (see Knudson: [fig. 7], [fig. 8] for a hierarchal structure including a parent category with a subset of categories within the parent category; see also Knudson: [col. 1, ll. 40-41], [col. 6, ll. 4-35]).

4. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. in view of Goode et al.

**Regarding claim 14:** Knudson discloses a method of providing a subscription-on-demand service for an interactive information distribution system comprising the steps of: providing a programming selection menu through which a subscriber selects programming for a personal subscription-on-demand service; selecting programming to define said personal subscription-on-demand service; and accessing programming for a predefined price and period (see [fig. 2], [figs. 6-8], [col. 3, ll. 9-16], [col. 4, ll. 58-65], [col. 6, ll. 29-31])

Knudson is silent on storing programming identification codes associated with said selected programming and a subscriber identification number; enabling said subscriber, through use of said subscriber identification number, to access said personal subscription-on-demand service by paying a single predefined price for access to the programming identified by the programming identification codes for a predefined period.

Goode teaches storing programming identification codes associated with said selected programming (such as MPAA ratings) and a subscriber

identification number; and accessing said programming through the use of said subscriber identification number (see [figs. 2-5], [pp. 2-3, ll. 33-5], [pp. 3, ll. 6-32], [pp. 3-4, ll. 32-1]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to associate some form of program identification code with a subscriber identification number such as a PIN where said association determines access, as taught in Goode, when providing subscription on-demand services, as taught in Knudson, because providing a PIN which can be associated with particular programming provides more flexible and useful security measures such as customizable access (see [pp. 2, ll. 9-12]).

**Regarding claim 15:** Knudson does not disclose the method of claim 14 wherein said subscriber identification number is one of a personal identification number, a terminal identification number, or an account number.

Goode teaches where a subscriber can be identified using a PIN, terminal identification number, or an account number (see [fig. 1 items 102 & 104], [pp. 2-3, ll. 33-5], [pp. 6-7, ll. 24-1]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to use other forms of identification such as PIN, terminal identification number or account number, as taught in Goode, when providing subscription on-demand services, as taught in Knudson, because providing a alternate forms of identification provides more flexible and useful security measures (see [pp. 2, ll. 9-12]).

**Regarding claim 16:** Knudson discloses apparatus for providing subscription-on-demand services within an interactive information distribution system comprising: service provider equipment containing an information server and a video session manager (see [fig. 1 items 22, 24, 26]; see also [col. 1, ll. 5-18], [col. 1, ll. 26-28], [col. 1, ll. 44-46], [col. 2, ll. 9-18], [col. 3, ll. 37-39] for a program guide system which reads on a video session manager); subscriber equipment containing a subscriber terminal and a display unit, where the service provider equipment is connected to the subscriber equipment by a communications network (see [fig. 1, item 32]); and said video session manager sends a plurality of executable menu applets to said subscriber terminal, said terminal executes each of said menu applets to generate interactive graphical user interface displays through which a subscriber selects a service; if the subscriber is said current subscriber of the selected service, the subscriber can select a subscription program for viewing; if said subscriber is not said current subscriber, the subscriber can become a subscriber to the selected service (see [abstract], [col. 1, ll. 57-63], [col. 3, ll. 2-16], [col. 3, ll. 27-31] [col. 4, ll. 58-65], [col. 8, ll. 58-63]; see [fig. 7] for a menu applet; see also [col. 3, ll. 45-62] transmitting data between the distribution facility and user equipment; [col. 3-4, ll. 63-3] for decoding by demodulation, the transmissions; [col. 4, ll. 42-47], [col. 4, ll. 58-65] for displaying an executed GUI received from the received transmissions which the user can select from).

Knudson is silent on the subscriber terminal sending a service request to said session manager for processing.

Goode however teaches an information server and session manager that provides data streams in response to selection request (which reads on a signal) for information from an interactive network interface used to communicate the selection to the provider (see [fig. 1 items 102 & 104], [pp. 3, ll. 6-34], [pp. 5, ll. 12-13], [pp. 2-3, ll. 33-5], [pp. 6-7, ll. 24-1]).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to use a selection signaling mechanism such as a information request to indicate a request for information, allowing the user to receive data, as taught in Goode, when receiving user selections indicating preferred subscription on-demand services, as taught in Knudson, because some form of signaling mechanism is needed to convey the user's selection via a graphical user interface to a remote device.

**Regarding claim 17:** Knudson discloses the apparatus of claim 16 wherein the subscriber terminal decodes and executes the applets that are sent by the session manager to produce said interactive graphical user interface displays (see [fig. 2], [figs. 7-9], [col. 3-4, ll. 63-3], [col. 4, ll. 32-37], [col. 4, ll. 42-47] for demodulating and displaying a GUI).

Knudson is silent on sending to the video session manager selection signals indicative of a selected option within said interactive graphical user interface displays.



Goode however teaches an information server that provides data streams in response to selection request (which reads on a signal) for information from an interactive network interface used to communicate the selection to the provider (see [fig. 1 items 102 & 104], [pp. 3, ll. 6-34], [pp. 5, ll. 12-13], [pp. 2-3, ll. 33-5], [pp. 6-7, ll. 24-1]).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to use a selection signaling mechanism such as a information request to indicate a request for information allowing the user to receive data, as taught in Goode, when providing subscription on-demand services, as taught in Knudson, because some form of signaling mechanism is required to convey the user's selection via a graphical user interface to a remote device.

**Regarding claim 18:** Knudson discloses the apparatus of claim 16 wherein said video session manager, to provide security and system administration (see [col. 3, ll. 22-31] but is silent on accessing a personal identification database, a terminal identification database, and a subscriber database that are contained in a network manager.

Good teaches where a subscriber can be identified using a PIN, terminal identification number, or an account number (see [fig. 1 items 102 & 104], [pp. 2-3, ll. 33-5], [pp. 6-7, ll. 24-1], [col. 7, ll. 6-9]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to user other forms of identification such as PIN, terminal

identification number or account number stored in a look-up-table, as taught in Goode, when providing authorization techniques for subscription on-demand services, as taught in Knudson, because providing a alternate forms of identification provides more flexible and useful security measures (see [col. 1, ll. 52-56]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Thomas whose telephone number is (571) 270-5080. The examiner can normally be reached on Mon. - Thurs., 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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J. Thomas

/Andrew Y Koenig/  
Supervisory Patent Examiner, Art Unit 2623